REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on July 27, 2007. Claims 1-31 have been rejected. Claims 1 and 19 are amended. Independent Claim 1 is amended to include limitations previously recited in dependent Claim 7 and should not raise new issues requiring additional search or consideration. Independent Claim 19 is amended to include limitations previously recited in dependent Claim 21 and should not raise new issues requiring additional search or consideration. Claims 7 and 21 are canceled. Claims 32-40 are added leaving Claims 1-6, 8-20, and 22-40 pending and subject to examination. Attached is a petition for a 3-month extension of time.

In order to advance prosecution of this Application, Applicants respond to each notation by the Examiner, and respectfully request reconsideration and favorable action in this case.

I. Specification

The Office Action has stated that the trademarks "MYLAR and TYVEK have been noted in this application" and "should be capitalized wherever they appear and be accompanied by the generic terminology." *Office Action*, page 2, paragraph 1. The specification has been amended. Accordingly, Applicants respectfully request that the Examiner withdraw the indication that the disclosure is insufficient.

II. Section 103(a) Rejections

A) Claims 1, 2, 4, 5, 9, and 24-26

Claims 1, 2, 4, 5, 9, and 24-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,897,324 to Tan ("*Tan*"), in view of U.S. Patent No. 4,997,374 to Simone ("*Simone*"). Applicants traverse this rejection for the reasons discussed below.

1) Claims 1, 2, 4, 5, and 9

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP 2143.03.

Here, obviousness has not been established because the cited references do not teach or suggest "wherein the book comprises a mode selection print element, and wherein selecting the mode selection print element one time causes the apparatus to be in a first mode, selecting the mode selection print element a second time causes the apparatus to be in a second mode, and selecting the mode selection print element a third time causes the apparatus to be in a third mode," as recited in independent Claim 1, as amended.

The Office Action acknowledges that *Tan* and *Simone* fail to teach "wherein the book comprises a mode selection print element, and wherein selecting the mode selection print element one time causes the apparatus to be in a first mode, selecting the mode selection print element a second time causes the apparatus to be in a second mode, and selecting the mode selection print element a third time causes the apparatus to be in a third mode." *Office Action*, page 7, paragraph 1. The Office Action relies instead on the entire keypad in U.S. Patent No. 5,902,116 to Rieber et al. ("*Rieber et al.*") to teach the mode selection print element:

> [T]he keypad of Rieber corresponds to a mode selection element, wherein selecting the element a first time (pressing any one of the number keys), successfully causes the apparatus to select the first harder difficulty (first mode), selecting the element a second time (pressing keys having different colors), successfully causes the apparatus to select the next harder difficulty (second mode), and selecting the element a third time (pressing keys having a particular shape and color), successfully causes the apparatus to select the hardest difficulty (third mode [sic]), wherein the learning ladder has three levels (4:4-18)

Id.

Rieber et al. merely discloses an apparatus having a keypad 16 with twelve buttons as shown below in FIG. 6. The operator in *Rieber et al.* enters responses using the buttons and the level of difficulty changes based on prior responses:

> [t]he concept of the invention is to provide a device 10 which requests responses from the operator, receives responses from the operator through the numeric keypad 16, and then which varies the intellectual difficulty of subsequent requests dependent upon the prior responses of the operator.

Rieber et al., column 3, lines 59-64.

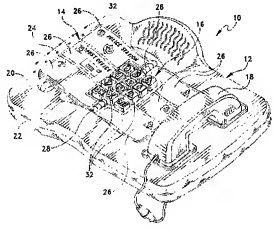


FIG. 6

First, twelve buttons do not teach a mode selection element.

Second, selecting a button on the keypad in *Reiber et al.* "one time" does not necessarily cause the apparatus to be in a first mode, selecting a button a "second time" does not necessarily cause the apparatus to be in a second mode, and selecting a button a "third time" does not necessarily cause the apparatus to be in a third mode. Examples of modes can be found in Claim 14. *Rieber et al* discloses that a selection on the keypad that corresponds to a correct answer from a multiplicity of answers increases the level of difficulty:

> Furthermore, and most importantly with respect to the concept of the invention, the device is operative for automatically selecting another data set having a different degree of intellectual difficulty from which subsequent requests for operator response may be

> derived dependent upon the appropriateness of at least one prior operator response. *In other words, if the operator responds appropriately to one or more requests, the device will select the next higher level of difficulty in order to challenge the operator.* In the example illustrated in FIG. 7, the device would notch up to requests which related to numbers only rather than shapes and numbers. The next request would then comprise "Please press the number 2 button." *As long as the operator continues to respond appropriately, the device will continue to select more difficult data sets.*

Rieber et al., column 4, lines 41-55 (emphasis added). A selection on the keypad that corresponds to a wrong answer decreases the level of difficulty:

> The device is further operative for decreasing the level of difficulty should the operator respond inappropriately. For example, if the operator did not appropriately respond to the requests in a particular level, the device would automatically notch down to the next lower levels and request a response.

Rieber et al., column 4, line 64-column 5, line 1. *Reiber et al.* does not teach "selecting...one time causes the apparatus to be in a first mode," "selecting ... a second time causes the apparatus to be in a second mode," and "selecting...a third time causes the apparatus to be in a third mode" because where an operator in *Reiber et al.* selects correctly "one time," incorrectly a "second time," and then correctly a "third time," the apparatus is back in the first mode, not the third mode. Further, *Reiber et al.* does not teach different operations modes, but a single operational mode that changes difficulty based on user input.

For these reasons, *Rieber et al.* fails to teach or suggest the combination of elements specifically recited in amended Claim 1 and its dependent Claims 2, 4, 5, 9, whether *Rieber et al.* is considered alone or in combination with *Tan* and *Simone*. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 1, 2, 4, 5, and 9.

2) Claims *24-26*

Obviousness has not been established because the cited references do not teach or suggest all the claim limitations. For example, the cited references fail to teach or suggest the following elements of Claim 24:

(e) a first region of the surface proximate the spine of the book; and
(f) a second region of the surface distal to the spine of the book,
wherein the first region is more sensitive to user interaction than the second region.

The Office Action relies on an input area with switches and an output area without switches of *Tan* to teach the first and second regions:

> Tan teaches a first region proximate (close to) the spine of the book (input areas, such as the uppermost "IN" region in Figure 5A, Item 120, are located close to the spine of the book); and a second region of the surface distal to (away from) the spine of the book (output areas, such as the lowermost "OUT" region in Figure 5A, Item 124, are located further away from the spine of the book than the topmost "IN" region), wherein the first region is more sensitive to user interaction than the second region (the input areas are switches are more sensitive to user interaction than the output areas, because the inputs are interactive, while the outputs are passive) [Claim 24]

Tan merely discloses a multimedia book with pages that can have an input area with switches (e.g., membrane switches) and an output area without switches:

> Referring to FIGS. 5A and 5B for the steps of bonding one of the multimedia books of the present invention. As shown in FIG. 5A, there are a plurality of pages containing multimedia input and output areas 120 and 124 connected to conductive strips 180. The conductive strips 180 are assembled into a data bus 112. An universal adapting connector 105 is formed at the end of the data bus 112. A simple method for connecting the multimedia book 110 to the data storage and process means 115 is to employ a flat signal cable 113 which has a connector head 118 which can be compatibly adapted to the adapting connector 105 of the multimedia book 110. The flat signal cable 113 is then connected to the data storage and process means 115 for operation with the multimedia book 110. The input areas 120 may be conventional membrane switches and the output areas 124 may be a conventional electro-luminescence (EL) material coated on the conductive strips 180 and patterned into specific shapes. The output areas 124 coated with EL material emit light when electrically charged.

Tan, column 5, lines 39-57. *Tan* discloses, however, in FIGS 5A and 5B (shown below) that the *input area 120 is away from* the spine of the book and that the *output area 124 is close to* the spine as shown below in FIGS 5A and 5B. That is, *Tan* discloses that the input area with switches is distal to the spine and the output area without switches is proximate to the spine. Thus, *Tan* fails to teach or suggest the elements of "a first region of the surface proximate the spine of the book" and "a second region of the surface distal to the spine of the book, wherein the first region is more sensitive to user interaction than the second region," as recited in Claim 24.

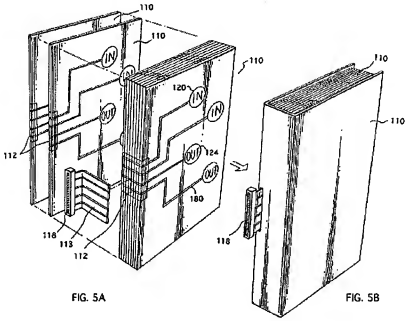


FIG. 5A FIG. 5B

Therefore, *Tan* fails to teach or suggest the combination of elements specifically recited in Claim 24 and its dependent Claims 25-26, whether *Tan* is considered alone or in combination with *Simone*. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 24-26.

B) Claims 3, 19, and 20

Claims 3, 19 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone*, and further in view of U.S. Patent No. 7,154,452 to Nakamura et al. ("*Nakamura et al*"). Applicants traverse this rejection for the reasons discussed below.

Dependent Claim 3 is allowable based on its dependence on independent Claim 1 and further because it recites numerous other patentable distinctions over the cited references.

As amended, Independent Claim 19 recites certain limitations substantially similar to those recited in independent amended Claim 1. Accordingly, for at least the reasons discussed above with respect to Claim 1, independent Claim 19 and its dependent Claim 20 are also allowable.

Accordingly, Applicants respectfully request reconsideration and allowance of Claims 3, 19, and 20.

C) Claims 6 and 27

Claims 6 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *"Tan"*, in view of *"Simone"*, as applied to Claims 1 and 24 above, and in further view of web.archive.org/web/20010108175500/www.ladlivers.com/creative/luxurylapreader.htm (*"Luxury Lap Leader"*). Applicants traverse this rejection for the reasons discussed below.

Dependent Claim 6 is allowable based on its dependence on independent Claim 1 and further because it recites numerous other patentable distinctions over the cited references.

Dependent Claim 27 is allowable based on its dependence on independent Claim 24 and further because it recites numerous other patentable distinctions over the cited references.

Accordingly, Applicants respectfully request reconsideration and allowance of Claims 6 and 27.

D) Claims 7, 8, 10, and 12-18

Claims 7, 8, 10, and 12-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone* as applied to Claims 1 and 10 above, and further in view of U.S. Patent No. 5,902,116 to Rieber et al. (*"Rieber et al."*). Applicants traverse this rejection for the reasons discussed below.

Dependent Claim 7 has been deleted and thus, the rejection is rendered moot. Dependent Claim 8 is allowable based on its dependence on independent Claim 1 and further because it recites numerous other patentable distinctions over the cited references.

Independent Claims 10 and 15 recite certain limitations substantially similar to those recited in independent amended Claim 1. For at least the reasons discussed above with respect to Claim 1, independent Claim 10 and its dependent Claims 12-14 and independent Claim 15 and its dependent Claims 16-18 are also allowable. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 8, 10, and 12-18.

E) Claims 11

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone* and *Rieber et al.*, and further in view of *Luxury Lap Leader*. Applicants traverse this rejection for the reasons discussed below.

Dependent Claim 11 is allowable based on its dependence on independent Claim 10 and further because it recites numerous other patentable distinctions over the cited references. Accordingly, Applicants respectfully request reconsideration and allowance of Claim 11.

F) Claims 21

Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone* and *Nakamura*, as applied to Claim 19 above, and further in view of *Rieber et al.* Claim 21 has been deleted and thus, the rejection is rendered moot. Applicants respectfully request withdrawal of the rejection.

G) Claims 22

Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone* and *Nakamura*, as applied to Claim 19 above, and further in view of U.S. Patent No. 5,000,327 to Kincheloe (*"Kincheloe"*). Applicants traverse this rejection for the reasons discussed below.

Dependent Claim 22 is allowable based on its dependence on independent Claim 19 and further because it recites numerous other patentable distinctions over the cited references. Accordingly, Applicants respectfully request reconsideration and allowance of Claim 22.

H) Claims 23

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone* as applied to Claim 1 above, and in further view of *Kincheloe.* Applicants traverse this rejection for the reasons discussed below.

Dependent Claim 23 is allowable based on its dependence on independent Claim 19 and further because it recites numerous other patentable distinctions over the cited references. Accordingly, Applicants respectfully request reconsideration and allowance of Claim 23.

I) Claims 28, 30, and 31

Claims 28, 30, and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone*, as applied to Claims 1 and 24 above, and further in view of U.S. Patent No. 6,130,773 to Jacobson et al. ("*Jacobson et al.*"). These rejections are traversed for the reasons discussed below.

1) Claims 28 and 30

Dependent Claim 28 is allowable based on its dependence on independent Claim 1 and dependent Claim 30 is allowable based on its dependence on independent Claim 24 and further because they recite numerous other patentable distinctions over the cited references. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 28 and 30.

2) Claim 31

Obviousness has not been established because the cited references do not teach or suggest all the claim limitations. For example, the cited references fail to teach or suggest the "a plurality of electrical elements under the surface…wherein the electrical elements are piezoelectric elements."

The Office Action relies on the piezoelectric element in *Jacobson* to teach the plurality of electrical elements:

> Jacobson teaches a book having a paper substrate, containing a piezoelectric element for activating a driver circuit and a display (8:1-17). The manner in which Jacobson uses the piezoelectric element to power circuitry is akin to a user-operable switch, as it causes the activation of the circuitry when the book is opened by a user. Such switches would replace the traditional membrane

> switches used by Tan. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated the piezoelectric switching elements of Jacobson in the platform as taught by Simone, in the print media apparatus of Tan, in order to convert the user's mechanical force of operating the switch into a low-cost power source for operating an electronic display or sound.

Office Action, page 12, paragraph 2.

Jacobson et al. discloses a paper substrate having a piezoelectric element. *Jacobson et al.*, FIG. 3. See also *Jacobson et al.*, column 8, lines 1-17. The piezoelectric element is however, located on the surface of the paper substrate, not "under the surface:"

> FIG. 5 illustrates the manner in which the invention can be applied to a paper substrate, such as a book, periodical or greeting card. In the depicted embodiment, a greeting card 500 comprises a central fold 502 and a piezoelectric element 505 *disposed thereon.*

Jacobson et al., column 8, lines 1-5 (emphasis added). For this reason, the cited references fail to teach or suggest the "a plurality of electrical elements under the surface...wherein the electrical elements are piezoelectric elements."

Therefore, *Jacobson et al.* fails to teach or suggest the combination of elements specifically recited in Claim 31, whether *Jacobson et al.* is considered alone or in combination with *Tan* and *Simone*. Accordingly, Applicants respectfully request reconsideration and allowance of Claim 31.

J) Claims 29

Claim 29 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Tan*, in view of *Simone* and *Reiber et al.*, as applied to Claim 10 above, and further in view of *Jacobson et al.* Applicants traverse this rejection for the reasons discussed below.

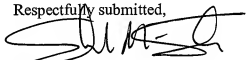
Dependent Claim 29 is allowable based on its dependence on independent Claim 10 and further because it recites numerous other patentable distinctions over the cited references. Accordingly, Applicants respectfully request reconsideration and allowance of Claim 29.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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